

Notice of Allowability

Application No.

10/632,284

Examiner

Robert Sellers

Applicant(s)

TOUR ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment and 37 CFR 1.132 declarations filed 16 July 2007.
2. ☒ The allowed claim(s) is/are 97-109, 134, 136 and 137.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Specification, page 1 according to the amendment filed July 16, 2007, line 2, delete "pending" and line 3, after "July 29, 2003" insert --; U.S. Patent No. 7,250,147; which is--.

Reinstate withdrawn claims 99 and 101-103.

The following is an examiner's statement of reasons for allowance:

2. The cancellation of claim 135 overcomes the 35 U.S.C. 112, second paragraph, rejection set forth in the non-Final rejection mailed January 17, 2007 on page 3, paragraph 5. The species of polymer in claim 135 has been redefined as an elastomer, thermoplastic or thermoset in new claims 134, 136 and 137 supported by page 18, line 32 of the specification.

3. The 37 CFR 1.132 declarations filed July 16, 2007 establish that that the Journal of the American Chemical Society article authored by Jeffrey L. Bahr, Jiping Yang and James M. Tour along with Dmitry V. Kosynkin, Michael J. Bronikowski and Richard E. Smalley is the work of Bahr, Yang and Tour, exclusively, who are the applicants. Accordingly, the article no longer qualifies under 35 U.S.C. 102(a) since it is not authored "by others" (MPEP § 2132.01, "Applicant Can Rebut *Prima Facie* Case By Showing Reference's Disclosure Was Derived From Applicant's Own Work).

4. The obviousness-type double patenting rejection over copending application no. 10/632,419 is rescinded since the claims as amended and allowed are directed to a diazonium-derivatized carbon nanotube product without the instantly claimed step (b) of dispersing them in a polymer. The claims of the instant application denote a method of derivatizing carbon nanotubes with a diazonium compound and dispersing it in a polymer constituting a distinct invention from the product of the copending application. Both the instant and copending applications are divisionals of parent application no. 10/470,517 issued as U.S. Patent No. 7,250,417 directed to a method of derivatizing carbon nanotubes with a diazonium compound without the instantly claimed dispersing in a polymer. This, the claims of all three related applications are directed to distinct inventions.

5. The obviousness-type double patenting rejection over provisional application no. 60/598,090 is the only rejection remaining due to the withdrawal of the other rejections as explained hereinabove. The instant application having an effective filing date of January 29, 2002 is earlier than that of the provisional application of August 2, 2004. According to MPEP § 804(I)(B)(1), Nonstatutory Double Patenting Rejections, if the obviousness-type double patenting rejection is the only rejection remaining in the earlier filed application, it should be permitted to issue as a patent without a terminal disclaimer. Therefore, this obviousness-type double patenting rejection is withdrawn and the application is deemed to be allowable.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Robert Sellers/

Robert Sellers
Primary Examiner
Art Unit 1712

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7/24/2007